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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/509,073    08/22/00    PIETRAS

B    MRKS/0012

EXAMINER

PM82/0329

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HAWKINS, J  
ART UNIT

PAPER NUMBER

3672  
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03/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/509,073	Applicant(s) PIETRAS ET AL.	
	Examiner Jennifer M Hawkins	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> | 20) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stator recited in claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 34. Correction is required.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 36, 216, and 217. Correction is required.

### ***Specification***

4. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.

Art Unit: 3672

- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
  - 1. Field of the Invention.
  - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

5. The disclosure is objected to because of the following informalities: on page 6, line 11, "20" should be changed to --30--.

The disclosure is further objected to because page 2, line 7 and page 3, lines 1 and 2 recite that further features of the invention are "set out" in claims 2-14 and 18-24. Throughout the prosecution of the application the claims may change or be canceled altering the meaning of the specification. Thus, these statements should be deleted and the features recited in the above claims added in their place to avoid any future confusion.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3672

7. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- I. Claim 1 recites the limitation "the required torque" in line 6. There is insufficient antecedent basis for this limitation in the claim.
- II. Claims 6, in line 2 of the claim, recites "hydraulic or pneumatic fluid" used to activate a sealing packer. The claim is considered vague and redundant. It is unclear if the Applicant is referring to the hydraulic and pneumatic fluid recited in lines 4 and 5 of claim 1 or separate fluid. It is suggested to line 2 of claim 6 be changed to recite --the hydraulic or pneumatic fluid--.
- III. Claims 14, in line 2 of the claim, recites "hydraulic or pneumatic fluid" allowed to pass through the body. The claim is considered vague and redundant. It is unclear if the Applicant is referring to the hydraulic and pneumatic fluid recited in lines 4 and 5 of claim 1 or separate fluid. It is suggested to line 2 of claim 14 be changed to recite --the hydraulic or pneumatic fluid--.

Claims 2-5 and 7-13 are also considered indefinite because the claim from which they depend, claim 1, is also considered indefinite.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1, 3-9, and 14-16 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/11322.

WO 98/11322 discloses a device for connecting pieces of pipe to form a casing string. The device includes a body (9 and 10) connected to a top drive within a derrick

Art Unit: 3672

and an inflatable elastomeric gripping member (11). The top drive system includes an elevator for supporting the casing string. The gripping member functions not only to grip the inside of the pipe but as a sealing packer to prevent fluid from flowing between the device and the casing. The body of the device includes a longitudinal passage through its length and a pair of smaller flow passages (19 and 20) within the larger, longitudinal passage. The smaller passages are used to pressurize the annulus (18) between the device and the casing (passage 19) and to inflate the gripping member (passage 20). The longitudinal passage allows fluid to flow into the casing below the gripping member. (See pages 5-7 and Figures 1 and 6)

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Delano .

Delano discloses an apparatus used to run casing into a wellbore. The apparatus includes an upper slip section (44), a middle tong section (46), and a lower seal section (48). The upper section includes a series of blade shaped slip sections (126 and 128) that are controlled by a pressure sensitive piston (146) and a spring (150). The upper portion of the slip section includes a set of spline recesses that engage the splines on a conduit (68) that connects to apparatus to the traveling block. The middle section contains a plurality of tong dies (168 and 170) that are forced into engagement with the casing wall by a camming mechanism (180). The lower section includes a packer (186) and a series of guides (192) that aid in stabbing in the casing. (See col. 3, lines 1-15, col. 4, lines 45-67, col. 5, lines 1-60, and Figures 1-4)

WO 98/11322 discloses all of the limitations of the above claims except for the upper portion of the body including spline recesses and the gripping member having blades. Delano teaches an apparatus for running casing that includes spline recesses on the upper end of the body and a series of blade slips. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the spline recesses of Delano on the device of WO 98/11322 in order to have been able to easily detach and replace the device when necessary. Further, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the blade slips of Delano on the device of WO 98/11322 in order to have provided a more secure means for gripping the casing.

12. Claims 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Boyadejeff and Albright et al.

Boyadejeff discloses a well drilling apparatus that includes a top drive (20), an elevator (118), a swivel (31), and a hydraulic compensating piston/cylinder system (110). The swivel allows fluid to be supplied to the cylinders by the gooseneck (33) and includes bearings within the connection between the swivel and a portions of a connecting rod (34) of the piston/cylinder system. The cylinder of the system (57) is connected to the drill string by lower external threads (59). The apparatus further includes a spring means to urge the system upward (see col. 3, lines 1-20). (See col. 5, lines 50-67, col. 8, lines 5-45, and Figures 2 and 10-12)

Albright et al. discloses a wellbore tubular compensator system. The system includes a weight compensating piston/cylinder assembly that is controlled by either hydraulically or pneumatically. (See col. 9, lines 30-55)

WO 98/11322 discloses all of the limitations of the above claims except for the casing support being carried by pneumatically operated weight compensating pistons. Boyadejeff teaches a tubing support system that includes compensating pistons. Albright et al. teaches a weight compensation system that includes pistons that are controlled either hydraulically or pneumatically. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the

Art Unit: 3672

tubing support system of Boyadejeff in conjunction with the weight compensating pistons of Albright et al. with the pipe connecting device of WO 98/11322 in order to have been able to use the device with pipes of various lengths, thus weights, without overloading the system (see col. 1, lines 60-65 of Albright et al.).

Regarding claim 13, WO 98/11322 discloses all of the limitations of the above claims except for bearings between the tubing support and the body of the device. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the swivel system with bearings of Boyadejeff to support the device and casing of WO 98/11322 in order to have not only supported the tubing but allowed the tubing and device to rotate freely.

13. Claims 17 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Delano, Mullins, and Littell.

Mullins discloses a casing filling and circulating system that includes a bull nose guide and a valve (42) for venting fluid from the casing string. (See col. 3, lines 60-67 and col. 4, lines 1-10)

Littell discloses an apparatus raising sections of casing. The apparatus includes a wedge locking assembly (45). (See page 2, lines 10-40 and 66-85)

Regarding claim 17, WO 98/11322 discloses all of the limitations of the above claims except for a wedge locking system, a means to prevent spillage of drilling fluid, and a positive locking means within the grapple. Littell teaches a wedge locking assembly and Mullins teaches a valve that prevents mud from spilling on the rig floor (see col. 3, lines 65-67 and col. 4, lines 1-2 of Mullins). Delano teaches a spring that holds blade slips in an upward position. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the locking assembly of Littell, the valve of Mullins, and the locking means of Delano in the device of WO 98/11322 to have, one, secured the device to the casing while the device is being maneuvered (see page 2, lines 75-85), two, prevented drilling fluid from spilling on the rig floor and thus the rig operators (see col. 3, lines 65-67 and col. 4, lines 1 and 2), and three, insured that the gripping member maintained contact with the casing.



In regards to claim 22, the device of WO 98/11322 would inherently be able to be used with various sizes of tubes. The device would expand to the size of the tube being used be it large or small.

Regarding claim 23, It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used the bull nose guide of Mullins on the device of WO 98/11322 in order to have provided a means for guiding the device into the piece of casing.

14. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11322 in view of Delano, Mullins, and Littell as applied to claim 17 above, and further in view of Boyadejeff.

In regards to claim 18, WO 98/11322, Delano, Mullins, and Littell disclose all of the limitations of the above claims except for a gripping member that is connected to a hydraulic piston assembly. Boyadejeff teaches a hydraulic piston assembly with a biasing spring and a cylinder attached to the upper end of the drill string by threads. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the piston assembly of Boyadejeff in the device of WO 98/11322 in view of Delano, Mullins, and Littell in order to have supported the weight of the casing string without damaging the entire assembly (see col. 3, lines 1-20).

In regards to claim 19, WO 98/11322, Delano, Mullins, and Littell disclose all of the limitations of the above claims except for a gripping member that is biased toward a failsafe position by a spring. Boyadejeff teaches a hydraulic piston assembly with a biasing spring and a cylinder attached to the upper end of the drill string by threads. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included biasing spring of Boyadejeff in the device of WO 98/11322 in view of Delano, Mullins, and Littell in order to have urged the device upward when it is necessary to quickly remove the device and/or the piece of casing from the wellbore (see col. 3, lines 1-20).

In regards to claim 20, WO 98/11322, Delano, Mullins, and Littell disclose all of the limitations of the above claims except for a gripping member that includes a cylinder attached to the device by threads. Boyadejeff teaches a hydraulic piston assembly with a biasing spring and a cylinder attached to the upper end of the drill string by threads. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the cylinder attached to the device by threads of Boyadejeff in the device of WO 98/11322 in view of Delano, Mullins, and Littell in order to have been able to easily detach and replace the device when necessary.

In regards to claim 21, WO 98/11322, Delano, Mullins, and Littell disclose all of the limitations of the above claims except for a slip-ring assembly. Boyadejeff teaches a swivel that allows fluid to be supplied to the cylinders by the gooseneck (33) and includes bearings within the connection between the swivel and a portions of a connecting rod (34) of the piston/cylinder system. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have included the swivel of Boyadejeff in the device of WO 98/11322 in view of Delano, Mullins, and Littell in order to have provided a means for rotating the drill string while hydraulic power was being supplied to the pistons.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Timmons discloses a method and apparatus for removing pipe from a wellbore. The apparatus includes a set of expandable blade slips for securing the tool to the casing.

Johnson discloses a tool for removing stuck pipe from a wellbore. The tool includes expandable slips and a bull nose guide.

Abbott et al. and GB 2224481 disclose an internal elevator that includes a series of expandable gripping members. The gripping members are expanded by the movement of a hydraulic piston.

Art Unit: 3672


Jordan et al. and Stokley disclose a casing circulation tool that includes a packer tube that is expandable by hydraulic pressure. The tool also includes a guide member.

Coone disclose an apparatus for circulating drilling fluid in a wellbore while casing is being run into the well. The apparatus includes a guide nose and an expandable gripping member. Fluid is circulated into the casing through a bore that extends through the length of the apparatus.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer M Hawkins whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Friday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-7687 for regular communications and (703) 306-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

JMH   
March 23, 2001

  
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